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09/750,369	12/28/2000	Takehiko Yoshida	38195.33	7895

7590

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EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/750,369

Applicant(s)

YOSHIDA, TAKEHIKO

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-2, 4, 6-7 and 12-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Pellicano U.S. Patent No. 6,386,707.**

Referring to claim 1. Pellicano discloses a networked-based eyeglass lens and frame ordering and marketing system comprising:

- A user interface unit (at least Figure 1(a), "10");
- An electronic service center (at least Figure 1(a), "30");
- At least one of a network and a data transmission system connecting the user interface and the electronic service center (at least Figure 1(a), "20");
- An eyeglass frame selection means (at least abstract);
- Means for creating display information relating to eyeglass frames (abstract);

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- Vision testing means for testing vision of the user (at least column 1, line 51 to column 2, line 29);
- An eyeglass lens selection means for selecting eyeglass lenses from among a plurality of eyeglass lenses in response to user input (at least column 1, lines 6-10);
- An eyeglass ordering and marketing means (at least abstract); and
- A display information creating means (at least claim 9).

Even though the language of claim 1 (page 65, line 18 through page 66, line 6) is not considered an invocation of 35 U.S.C. 112, sixth paragraph, it is noted that these functional recitations are not accorded any patentable weight because it merely recites the intended use of a structure. Office personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Please see MPEP section 2106.

Referring to claim 2. Pellicano further discloses a system wherein the electronic service center comprises:

- An electronic shop information processing means (at least abstract);
- A display information creating means for creating display information such as electronic catalogs in response to a request from the user interface unit (at least column 6, lines 50-55)

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- A lens ordering processing means (at least abstract);
- A order settling means (at least abstract); and
- A WWW server (at least Figure 1(a), "20").

Referring to claim 4. Claim 4 is rejected under the same rationale as set forth in claim 1.

Referring to claim 6. Claim 6 is rejected under the same rationale as set forth in claim 1.

Referring to claim 7. Claim 7 is rejected under the same rationale as set forth in claim 2.

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth in claim 1.

Referring to claim 13. Claim 13 is rejected under the same rationale as set forth in claim 2.

Referring to claim 14. Claim 14 is rejected under the same rationale as set forth in claims 1 and 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 5, 8-11 and 15-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pellicano U.S. Patent No. 6,386,707, in view of Izumitani U.S. Patent Application Publication No. 2003/0090625.**

Referring to claim 3. Pellicano discloses a system according to claim 1 as indicated supra. Pellicano does not expressly disclose the limitations as set forth below in claim 3. Izumitani discloses a system as set forth below in claim 3, wherein said electronic service center comprises:

- A user information registration means for registering and controlling a user's information including a face image sent from the user interface unit (Figure 1, "Take Frontal Image");
- A frame selection information input means (at least Figure 1, "Select Basic Design");
- A database control means for storing and controlling a user's face input by the user information registration means (at least Figure 5);
- A frame image registration means for inputting frame images provided by the electronic service center (at least Figure 4);
- A frame selection means that is adapted to select an appropriate one of frame functional structures, frame ornamental structures, and frame images, stored by the frame information registration means, for each frame of the database control means, corresponding to frame selection criteria requested by the user and controlled by the database control means, and is adapted to create or select a frame image for displaying eyeglass frames of different types (at least Figure 4);

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- An image processing means that is adapted to output via an output means an eyeglass-wearing image with an eyeglass frame image, selected by said frame selection means, being combined with the face image data controlled by the database (at least Figure 4, Figure 5, and Figure 6).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Pellicano to have included the limitations of Izumitani as discussed above in order to facilitate an interactive system and methodology for conducting vision examinations and prescribing eyeglasses over the Internet (Pellicano: column 1, lines 6-10).

Even though the language of claim 3 (page 66, line 20 through page 67, line 12) is not considered an invocation of 35 U.S.C. 112, sixth paragraph, it is noted that these functional recitations are not accorded any patentable weight because it merely recites the intended use of a structure. Office personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Please see MPEP section 2106.

Referring to claim 5. Claim 5 is rejected under the same rationale as set forth in claim 3.

Referring to claim 8. Claim 8 is rejected under the same rationale as set forth in claims 1 and 3.

Referring to claim 9. Claim 9 discloses a system according to claim 8 as indicated supra. Claim 9 is rejected under the same rationale as set forth in claims 2 and 8.

Referring to claim 10. Claim 10 discloses a system according to claim 8 as indicated supra. Claim 9 is rejected under the same rationale as set forth in claims 2 and 8.

Referring to claim 11. Pellicano in view of Izumitani discloses a system according to claim 8 as indicated supra. Pellicano further discloses a system wherein said electronic service center comprises:

- A user information registration means (at least Figure 1(a) and Figure 1(b));
- A vision test information input means (at least Figure 1(a) and Figure 1(b));
- A database control means (at least Figure 1(a) and Figure 1(b));
- An image processing means (at least Figure 1(a) and Figure 1(b));
- A vision data creation means (at least Figure 1(a) and Figure 1(b)); and
- A WWW server (at least Figure 1(a) and Figure 1(b)).

It is noted that the means plus function recitations as described supra are intended use and is given little patentable weight. Office personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).



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Referring to claim 15. Claim 15 is rejected under the same rationale as set forth in claim 8.

Referring to claim 16. Claim 16 is rejected under the same rationale as set forth in claim 8.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

MIZUNO et al., U.S. Patent Application Publication US 2002/0034921, March 21, 2002, discloses an eyeglass lens processing system.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

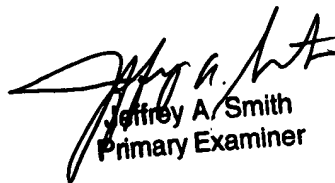
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August 20, 2003

  
Jeffrey A. Smith  
Primary Examiner